

## REMARKS

Claims 1-19 and 21-31 were pending in the present application. In the above amendments, claims 21-29 are amended. Applicants respectfully submit that the amendments are proper after final as they implement the suggestions of the Examiner in order to place the claims in condition for appeal with no further search required. Therefore, after entry of the above amendments, claims 1-19 and 21-31 remaining pending in this application. Applicants believe that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

### **Summary of the Office Action**

In the Office Action, claims 21-29 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter and under 35 U.S.C. § 112, second paragraph, as being indefinite. Also in the Office Action, claims 1-19 and 21-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publ. No. 2003/0112952 to Brown et al. and U.S. Patent No. 7,003,327 to Payne et al. further in view of U.S. Patent Publ. No. 2003/0063590 to Mohan et al. These rejections are traverse and reconsideration is requested based upon the foregoing amendments and the following remarks.

### **Response to Rejections of Claims 22-29 Under 35 U.S.C. § 101 and 35 U.S.C. § 112**

In response to the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112, claims 21-29, claim 21 is amended to implement the amendment suggested by the Examiner in the Office Action. Claims 22-29 are amended in order to recite the subject matter in a form compatible with the amended claim 21. Applicants thank the Examiner for suggesting a suitable claim amendment, and respectfully submit that the amendments overcome the basis for the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 21-29 under 35 U.S.C. § 101 and 35 U.S.C. § 112.

**Response to Rejections of claims 1-19 and 21-31 Under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejections of claims 1-19 and 21-31 under 35 U.S.C. § 103(a) and reconsideration of the claims on the basis that the Office Action fails to establish a *prima facie* case of obviousness.

As explained in M.P.E.P. 2143.01, if a proposed modification in a combination of references would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In the present case, the intended purpose and operational principle of Brown is to provide a call switching center capability of connecting a first party to a second party on the basis of more than just a telephone number. *See Brown Abstract, figures, specification and claims*. In contrast, the claims of the present application are directed to a wireless device (e.g., a cell phone), a method that can be implemented in a wireless device, and a computer-readable medium with instructions that can be implemented in a wireless device. Thus, the Office Action attempts to modify a call switching center to turn it into a cellular telephone or similar wireless device. This modification necessarily requires that the system in Brown be modified so that it cannot perform its intended purpose, which is to connect a first party to a second party, since the wireless device is the second party. Also, this modification necessarily change the principle of operation of Brown since it requires changing the system's operation from performing the switching/routing processes of Brown into the call screening processes recited in claims 1-19 and 21-31. The modification asserted in the Office Action necessarily eliminates the call processor functionality

that is the principle element, process and purpose Brown. Therefore, the combination of references in the Office Action is improper in view of the law explained in M.P.E.P. 2143.01. Accordingly, the Office Action fails to establish a *prima facie* case of obviousness for claims 1-19 and 21-31.

The combination of Brown with Payne and Mohan is also improper because Brown teaches away from the combination and against the subject matter recited in claims 1-19 and 21-31. As noted above Brown teaches methods and systems for connecting a first caller to a second caller in a switching center or other call processor. Even in the disclosed embodiment in which the call processor is in a mobile device 120b, the call is not placed to the mobile device, but rather the mobile device acting as a call processor directs the call to another device. *See* para. [0047]. Thus, Brown teaches away from call screening in a second caller receiver. As explained in MPEP 2141.02, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Contrary to the law, the Office Action ignores the teachings of Brown to improperly mix and match various unrelated components and modules within the communication system of Brown to find the components and processes recited in claims 1-19 and 21-31 based upon impermissible hindsight. Therefore, the combination of references asserted in the Office Action is improper for this additional reason, and thus, fails to establish a *prima facie* case of obviousness for claims 1-19 and 21-31.

As admitted in the Office Action, the secondary references fail to disclose all elements recited in claims 1-19 and 21-31, thus even if Brown is removed from the combination since it teaches away from the claims, the remaining combination of Payne and Mohan fails to disclose all elements recited in the claims.

Since the Office Action fails to establish a *prima facie* case of obviousness for claims 1-19 and 21-31 and the primary reference teaches away from the alleged combination and claims, Applicants respectfully submit that claims 1-19 and 21-31 are allowable over the cited prior art. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 1-19 and 21-31 under 35 U.S.C. § 103(a).

## CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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